PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/507,018
Filing Date:	March 21, 2006
Applicant:	Jonas Ove Phillip ELIASSON, et al.
Group Art Unit:	2629
Confirmation No.:	7708
Examiner:	Christopher E. Leiby
Title:	TOUCH PAD, A STYLUS FOR USE WITH THE TOUCH PAD, AND A METHOD OF OPERATING THE TOUCH PAD
Attorney Docket:	12090-000021/US

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Claims 61-64, 70, 72-74, 76-97, 103, 105-107 and 109-120 are pending in this application. Claims 61, 93 and 94 are written in independent form. The pending claims were finally rejected in the Office Action mailed June 13, 2008. This Pre-Appeal Brief Request is submitted in response to the final rejection of the pending claims.

REMARKS

Claims 61-64, 70-97 and 103-120 are rejected under 35 U.S.C. § 103(a) as being obvious over US 5,502,568 to Ogawa et al. (Ogawa) in view of US 2001/0005004 to Shiratsuki et al. (Shiratsuki) and further in view of US Patent 6,577,299 to Schiller et al. (Schiller).

Applicants respectfully submit that the prior art rejection fails to establish a *prima facie* case of obviousness due to clear legal and/or factual error.

In rejecting the claims, it is alleged that Ogawa discloses all of the features of the independent claims, except a "light transmissive element...adapted to transmit received light inside of the light transmissive element along the first surface nor that two CCD sensors are used for triangulation" In an effort to overcome the admitted deficiency, Shiratsuki is combined with Ogawa and it is alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ogawa with the teachings of Shiratsuki.

I. Legal Error

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (37 CFR §1.104; see also MPEP 706.02(j)).

It is alleged in the Office Action that Shiratsuki shows "light transmissive elements which are capable of transmitting light along the surface to light detecting sensors." However, Shiratsuki fails to disclose, nor does the Office Action identify any structure alleged to correspond to, a component used for transmitting light along the surface to light detecting sensors. Thus, there is legal error in the failure to comply with 37 CFR §1.104.

Further, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some motivation or suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings and the teaching or suggestion to combine references must both be found in the prior art, and not based on applicant's disclosure. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claimed limitations (MPEP §2142).

It is alleged in the Office Action that it would have been obvious to one of skill in the art at the time of the invention to replace the pattern plate 21 of Ogawa (alleged to correspond to the claimed "light transmissive element") with the light transmissive element of Shiratsuki (not identified, as discussed above).

Shiratsuki relates to an irregular pattern detector which captures, as images, irregular patterns such as fingerprints (paragraph [0002]). Shiratsuki addresses problems in fingerprint ID apparatuses caused by deformation of a detected image (paragraphs [0004]-[0009]). As shown in Fig. 5 of Shiratsuki, a finger F is placed on a light guide body 2 and a light from a light source 1 is transmitted through the light guide body to the finger F. A spherical mirror 2C is used to reflect detected light to an imaging lens 4 that is then detected by a camera 3.

In contrast, Ogawa relates to an optical position detecting unit that includes an optical position pointer 2 and a single photodetector 4 arranged above a surface of the screen 1a. The optical position detecting unit detects the coordinates of a position pointed by the optical position pointer 2 on the basis of the distance to a light emitting portion and direction of incidence of light, both of which are detected by the single photodetector 4 above the surface of the screen 1a (column 6, lines 13-25). Light is transmitted over a display surface of the image pickup unit and a distance to the pointer 2 is calculated by making use of a pattern image of a pattern plate 21 projected onto a linear image sensor 23 (column 8, lines 59-62; Fig. 1, Fig. 3). An angle to the pointer 2 is determined by using a pattern of suitable and known characteristics on the pattern plate 21 (column 9, lines 35-40, column 13, lines 23-26).

It is alleged that the motivation to modify the Ogawa device with the teachings of Shiratsuki is to "increase the precision detected by the CCD from the light pen's output." However, one of skill in the art would not seek to modify Ogawa because to do so would not "increase the precision detected by the CCD from the light pen's output" but rather, would render the device inoperable.

A proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference, the proposed combination of references fails to render the claims obvious (MPEP §2145(X)(D)).

In the present case, the proposed modification would render the device inoperable for its intended purpose because, for example, Shiratsuki shows, at Fig. 5, the spherical mirror 2 is a waveguide, the imaging lens 4 is a CCD and thus, the incident light L1 would be the "light pen of Ogawa." Therefore, light entering the pattern plate 21 of Ogawa would be redirected, as is the light in Shiratsuki, inside the pattern plate to an edge of the pattern plate 21. Therefore, it would not be possible to detect the position of the position pointer 2 of Ogawa.

Further, the photodetector 4 of Ogawa relies on a pattern being projected on the plate 21 onto a CCD linear image sensor 23. By modifying Ogawa as suggested in the Office Action, the projected pattern could no longer be projected onto the CCD thereby rendering the Ogawa device inoperable.

For at least the above reasons, the rejection of the claims is clear legal error and the rejections should be withdrawn.

II. Factual Deficiencies

There are factual deficiencies in the rejection of the claims because the combination of references, whether considered alone or in combination, fails to disclose or suggest all of the features recited in the rejected claims. For example, it is alleged that Ogawa alone discloses a light transmissive member that comprises a light transmissive display or monitor, as recited in claims 64 and 97. However, in Ogawa, the alleged light transmissive member 21 is merely a surface of the photodetector 4 (see Fig. 3). Although it is alleged that col. 3, lines 52-57 and col. 5, lines 37-65, support the allegation that the pattern plate 21 is a "display or monitor," neither of cited sections supports the allegation. Column 5, lines 37-65, recites that the optical coordinate input unit includes a cathode ray tube (CRT) 1. Thus, the CRT is not a component of the pattern plate 21 (photodetector 4) identified in the Office Action as corresponding to the claimed "light transmissive member."

It is also alleged that Ogawa alone discloses the additional features of claims 82/114. Specifically, it is alleged that Ogawa discloses a "touch pad further comprising means for receiving light from outside the pad." The "image pickup unit" of Ogawa is alleged to correspond to the claimed "means for receiving light." The image pickup unit is identified in Ogawa as being the linear image sensor 23 of the photodetector 4. However, in rejecting independent claim 61, it was alleged that the linear image sensor 23 was the claimed "second means adapted to receive light transmitted by the surface."

As the claimed "means for receiving light" in claims 82/114 is introduced as a new element (i.e., by recitation of "further comprising"), interpreting the linear image sensor 23 as corresponding to both elements fails to comply with the Doctrine of Claim Differentiation which presumes a difference in means and scope when different phrases are used in separate claims

Tandom Corp. v. U.S. International Trade Commission, 831 F.2d 1017, 1023, 4 USPQ2d 1283, 1288 (Fed. Cir. 1987).[1] Thus, the linear image sensor cannot and does not correspond to the claimed "means for receiving light."

It is further alleged that the combination of Ogawa and Shiratsuki render claims 84/116 obvious in as much as Shiratsuki allegedly discloses "at least two lens or mirror means form part of the light transmissive element" at Fig. 5, "reference 2d with 2." However, reference 2d is described in Shiratsuki as an "opening" in the light guide body 2. Thus, the opening cannot be interpreted as at least two lenses or mirror means.

For at least the above reasons, the rejection of the claims is clear factual error and the rejections should be withdrawn.

CONCLUSION

Appellants respectfully request that the Panel reconsider and withdraw the final rejection of the pending claims and pass the application to allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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[1] Moreover, a single component in an accused device cannot be held to satisfy two claim elements where such a holding would be inconsistent with language in the claim regarding the structural relationship between the two elements. *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 398-99 (Fed. Cir. 1994).